

REMARKS

Claims 1 and 3-30 are pending in this application. Claim 1 has been formally amended to clarify claimed elements of the present invention. Applicant respectfully submits that no new matter has been added by these amendments and support for these amendments can be found throughout the specification and previous claims.

Response to the Declaration

The Declaration of Joanne Bonnell (including Exhibits A and B) filed with the response of July 25, 2005 was deemed to be persuasive to overcome the Rejection of claims 1 – 30 under Millary et al. in view of Barber in the Examiner’s response to Argument contained in the Office Action dated October 18, 2005. However, in the Rejection dated March 29, 2006, the Examiner re-considers the previously stated sufficiency and persuasiveness of the Declaration due to the Declaration providing no evidence of actual reduction to practice. The Rejection states that this may be corrected by relying on the filing date of the provisional application as constructive reduction to practice and including evidence supporting diligence from prior to the effective date of the Millary reference.

The earliest effective date of the Millary reference is November 22, 2002 and the Examiner has identified a screen capture of “healthpay 24” dated August 2002 which is the product disclosed in provisional applications 60/428,311 and 60/428,977 indicating that the system was “for sale” on August 3, 2002.

However, Applicant respectfully submits that, in accordance with MPEP 715.07 III(C), the claimed invention was conceived prior to the effective date of both the reference and the “on sale” evidence. Additionally, Applicant respectfully submits that due diligence on the part of the inventor was taken prior to the effective date(s) and continued through filing of the provisional application serial number 60/432,765 on December 12, 2002 on which the claimed invention is based.

In support of Applicants assertion of prior invention under MPEP 715.07 II (C), attached are Declarations of the Inventor, Joanne Bonnell, her supervisor Luis Castillo, and myself, the Attorney who drafted the subject application made under 37 CFR 1.131 (Exhibits I – III, respectively). Applicant submits that for the reasons discussed below, the present claimed invention was invented prior to the Millary system.

Joanne Bonnell, as stated in the attached Declaration (hereinafter "Bonnell Declaration") conceived the idea for the automated cash management process and presented this process to Jane Henderson during the first quarter of 1997 sometime after beginning her employment with Siemens Medical Solutions. Ms. Bonnell continued to work on and refine this idea and in January of 1999, after reporting to Craig Patton and disclosed the "automated cash management process" invention. Ms. Bonnell was directed to speak with Morgan Pape in the General Financial Systems department and further disclosed the "automated cash management process" to Mr. Pape. Applicant would like correct a misstatement contained in the Declaration of Ms. Bonnell filed on 7/25/05. Point 7 of the 7/25 Declaration said that the meeting with Mr. Pape occurred "on or about February 1998". However, as corrected in the "Bonnell Declaration" filed herewith, the meeting took place on or about February 1999. Upon receiving positive feedback from Mr. Pape, further development and refinement of the system by Ms. Bonnell took place. This discussion is evidenced by Exhibit B attached to the Bonnell Declaration which shows that the cash management process was reviewed with Morgan Pape on or about the identified time frame.

On or about August 1999, Ms. Bonnell created a diagram of intended operation of the claimed system. This diagram is attached to the Bonnell Declaration as Exhibit A and the accuracy of the creation date of this diagram is sworn by Ms. Bonnell in the attached Declaration. Therefore, Applicant respectfully submits that in view of the diagram of Exhibit A, Applicant conceived the claimed invention at least as early as August 1999. Specifically, evidence of conception is found in the August 1999 diagram. The August 1999 diagram is a block diagram showing a direct support for operation of the claimed

method. Specifically, the diagram shows multiple instances of a cash register which is known to include a plurality of processing devices able to be programmed to perform specific functions. The diagram clearly shows “an electronic file” containing message data being transmitted between the “register” and the “bank”. Additionally, the diagram shows a column of income categories titled “actual cash received” from a plurality of departments. A source identifier identifies a specific department to be used by a processor able to run the “settlement process”. The box entitled “consumer and insurance payment” transmits message data to the bank which further transmits the message data back to the “cash register” system. The message data transmitted by the “bank” to the “cash register” is data “identifying medical insurance reimbursement amounts received or services rendered to multiple patients”. The “automated processes” performed by the claimed “data processor” are reasonably shown by the blocks extending from the “settlement process” block of the diagram. The “message data” received by the “register” is used to perform the claimed functions. Therefore, Applicant respectfully submits that sufficient evidence in accordance with MPEP 715.02 is submitted to prove conception of the claimed invention prior to filing of the Millary reference.

After continued work on the system, and in conjunction with work on other regularly scheduled projects, Ms. Bonnell discussed the operation of the system with Luis Castillo who was the Patent Manager for the General Financial Systems Department of Siemens Medical Solutions on or about February 2001. The details of the conversation can be found in Point 11 of the Bonnell Declaration and are corroborated by Mr. Castillo, now a Senior Vice President at Siemens Medical Solutions, in Point 4 of the Declaration by the same attached hereto. The specific details regarding the operation of the claimed system were disclosed by Ms. Bonnell to Mr. Castillo and correspond to the diagram of Exhibit A. Mr. Castillo instructed Ms. Bonnell to continue development and begin the formal write-up procedures associated with the internal patent application process. Applicant respectfully submits that the discussion between Ms. Bonnell and Mr. Castillo includes facts that are beyond a vague notion of solving a problem and include the “requisite means and their interaction” as required by *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G.1417 (D.C. Cir 1897).

Between February 2001 and November 18, 2002, Ms. Bonnell added a hardware and software embodiment of the claimed system and further added “automatically receiving message data corresponding to deposit information of respective healthcare facilities from their respective banking institutions on a regular basis”. The formal write-up was completed on November 18, 2002 when Ms. Bonnell submitted her Invention Disclosure Memorandum and Disclosure Documents (Exhibits A and B in the 7/25 Declaration which are incorporated herein by reference) in accordance with the accepted procedures used by Siemens Medical Solutions for internal inventors.

I received the Invention Disclosure and Memorandum on or about November 26, 2002. From the received documents I diligently prepared a provisional patent application which was presented to Ms. Bonnell for approval and filed on December 12, 2002.

Additionally, with respect to assertion regarding the sufficiency of the Invention Disclosure Documents submitted with the 7/25 Declaration, Applicant respectfully disagrees with conclusion of insufficiency. However, in view of the August 1999 diagram and conversation between Ms. Bonnell and Mr. Castillo, Applicant respectfully submits that evidence of conception of the claimed invention prior to August 2002 has been established in accordance with MPEP 715.02

However, the Examiner states that the passages cited in the 7/25 Declaration do not show “a message processor” as claimed. Applicant respectfully disagrees. Specifically, the Invention disclosure in Exhibit B of the 7/25 Declaration discloses a “cash register” system. A cash register system is well known to be an electronic processing device including a plurality of processors performing specified functions. Therefore, Applicant respectfully submits specific disclosure of “a message processor” and a “data processor” is not required under MPEP 715.02 as it is obvious that a cash register includes processing devices contained therein. Furthermore, as stated in lines 1 – 6 of Exhibit B of the 7/25 Declaration, the claimed “cash register” includes “additional functions to facilitate the full method of collecting payments, balancing cash, accounting

for these transaction and reporting". Therefore, the Disclosure Document clearly discloses a system beyond that of a typical "cash register".

Furthermore, Applicant respectfully disagrees with the Examiner's assertion that the Invention Disclosure teaches away from the claimed invention. The Invention Disclosure contains a disclosure of the claimed method by way of analogy. The disclosure by analogy is reinforced by the discussion between Ms. Bonnell and Mr. Castillo. Thus, Applicant respectfully submits that the conclusion of "programming" keys teaches away from "income source identifier identifying one of a plurality of departments" is erroneous. In fact, if a key were to be programmed to display "income category received" it would be obvious from the disclosure that "an identifier" identifying a source of the income be included.

Thus, in view of the above remarks, Applicant respectfully disagrees that the cited portion of the Invention Disclosure discloses reconciling cash. The cited section continues discussing transaction being "rung" into the register. However, as this disclosure was made by analogy, the use of a "cash register" able to perform predetermined functions reasonably includes receiving "message data" identifying payment from "one of a plurality of departments internal to said hospital providing said associated first income amount total value" as in the present claimed invention.

Additionally, Applicant respectfully disagrees with the Examiner's assertion that Exhibit B of the 7/25 Declaration fails to disclose an automatic process. In fact, the first line of the Exhibit clearly states that the invention is "an automated workflow process". Also, while the Exhibit discloses "initiation" of the process, there is no disclosure that the initiation is done by a user. Rather, initiation of a process in "an automated workflow process" clearly can be automatic as claimed in the present invention.

Therefore, in view of the attached Declarations and the above remarks, Applicant respectfully submits that the claimed invention was conceived prior to August 2002 and that sufficient diligence existed prior to August 2002 which continued through filing of

the Provisional Patent Application on December 12, 2002. Therefore Applicant respectfully submits that the claimed invention was invented prior to filing of the Millary reference.

Rejection of Claims 1-3-14 are rejected under 35 USC 112

Claims 1, 3-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, 5, 7 and 9 have been formally amended in accordance with the Examiner's suggestion to define "message data" in line 3 of claim 1 to recite "first message data". Additionally, claim 1 has been formally amended to recite that the "first message data" and "second message data" are automatically processed in the method claimed in claim 1. Furthermore, line 18 of claim 1 has been formally amended to state that "the combined cash income total value for said departments" refers to "all of the departments".

Claims 3, 5, 7 and 9 have been formally amended to define the "message data" contained therein to correspond to amended claim 1.

In view of the above remarks and amendments to the claims, it is respectfully submitted that this rejection has been satisfied and should be withdrawn.

Rejection of Claims 1 and 3-30 are rejected under 35 U.S.C. 103(a)

Claims 1 and 3-30 are rejected under 35 U.S. C. 103(a) as being unpatentable over Millary et al. in view of Barber et al.

In view of the attached Declarations under U.S. Patent Office Rule 131 executed by Joanne Bonnell, Luis Castillo and Alexander Burke, Applicant respectfully submits that the present invention as claimed in claims 1 and 3 – 30 was invented prior to the effective date of Millary et al. Furthermore, the citation of the “healthpay 24” screen capture dated August 2002 is also effectively predicated by the attached Declaration which, as required under MPEP 715.07(III)(C), shows conception of the claimed invention prior to effective date of Millary et al. coupled with due diligence from prior to the reference date to the filing date of the provisional application filed. Specifically, for the reasons discussed above in the section entitled Response to Declaration, Applicant respectfully submits that the present claimed invention was invented prior to the effective date of either August 2002 (screen capture) or November 20, 2002 of the provisional application filed by Millary et al.

Applicant respectfully submits that in view of the attached Declarations under 37 CFR 1.131, the present claimed invention antedates Millary et al. and thus, disqualifies the use of Millary et al. as prior art under 35 USC 103.

Barber et al. discloses a medical payment system that is provided in a physician's office and facilitates physician reimbursements as well as the processing of medical insurance claims. Barber et al. is concerned with providing information about services to a central system so that the central system is able to contact third-party vendors in order to satisfy any obligations resulting from the services, i.e. insurance reimbursement. Thus, Barber et al. discloses a system that is transaction specific. Barber et al. neither discloses nor suggests “a message processor for receiving message data including a first income amount total value, representing cash income received during a first time period” as in the present claimed invention. While Barber et al. does disclose providing monthly statements to either a physician or patient, the information used in producing the statement based entirely on an entered transaction at a remote terminal connected to the central processing unit. This is unlike the present claimed invention which is concerned with “cash income received during a first time period”.

Additionally, the Office Action states that Barber et al. disclose “receiving compensation for medical services provided represents receiving message data including second income amount value representing medical insurance reimbursement income

amounts and an associated patient identifier". Applicant respectfully disagrees. Specifically, while Barber et al. receives data from a plurality of sources, the data received thereby is not equivalent to "message data including a first income amount total representing cash income received during a first time period" and "second message data identifying medical insurance reimbursement income amounts" as in the present claimed invention. Barber et al. receives patient payment information from the patient based on services rendered to the patient and also receives information regarding reimbursement information from insurance companies wherein the reimbursement is directly related the services provided to the patient. Thus, this data is based entirely on a single transaction. The patient payment information in Barber et al is not analogous to "message data including first income amount total value" of the present invention. Additionally, the "message data" in Barber et al. is transaction specific and unlike the present claimed invention wherein the "message data" is **time period specific**. As the data in Barber et al. is directly related to the patient it cannot be related to "one of a plurality of departments internal to said hospital".

Applicant respectfully submits that there no motivation to modify Barber et al. to produce the present claimed invention because Barber et al. is concerned with transactional information derived from patient services and neither discloses nor suggests "a first income amount total value, representing income received during a first time period, an associated first income source identifying one of a plurality of departments internal to said hospital providing said associated first income amount total value" as in the present claimed invention.

Additionally, in view of the attached Declarations under 37 CFR 1.131 proving invention of the present claimed invention prior to the effective date of Millary et al., Applicant respectfully submits that the rejection under Millary et al. in view of Barber et al. is moot and should be withdrawn.

Having fully addressed the Examiner's rejections, it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicant's attorney at the phone number below, so that a mutually convenient date and time for a telephonic interview may be scheduled.

In view of the above amendments and remarks, Applicant submits that the Application is in condition for allowance, and favorable reconsideration is requested.

No additional fee is believed due with this response. However, please charge any fee associated with this Amendment to deposit account 19-2179.

Respectfully submitted,
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